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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,822	02/20/2002	Tomitaka Yamashita	SIMTEK6260	7485
25776	7590	10/06/2004	EXAMINER	
ERNEST A. BEUTLER, ATTORNEY AT LAW 10 RUE MARSEILLE NEWPORT BEACH, CA 92660			CHARIOUI, MOHAMED	
			ART UNIT	PAPER NUMBER
			2857	

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/683,822	YAMASHITA, TOMITAKA
	<b>Examiner</b> Mohamed Charioui	<b>Art Unit</b> 2857

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 09 July 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-5 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-3 and 5 is/are rejected.

7)  Claim(s) 4 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date. \_\_\_\_ .  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_ . 5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_ .

1. In view of the Appeal brief filed on 7/21/03, PROSECUTION IS HEREBY REOPENED. New ground of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

#### **DETAILED ACTION**

##### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Steiner (U.S. 4,291,404).**

Steiner teaches a signal inspection device for testing a plurality of electronic devices that receive inputs and output outputs signals in response thereto (see col. 3, lines 40-49), the signal inspection device comprising a memory circuit for storing an inspection program adapted to electronic devices to be inspected, the memory circuit

being capable of being programmed by a personal computer external to the signal inspection device and detachably connectable thereto for programming the memory circuit to suit the electronic device to be tested (see col. 4, lines 33-64 and col. 5, lines 35-45), a power supply for applying input signals to an electronic device detachably connected to the signal inspection device from the signal inspection device (see col. 4, lines 59-65), and a display for receiving and displaying output signals from the electronic device being tested in response to the applied input signals (see col. 4, lines 2-25).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Steiner in view of Endo (U.S. 5,327,350).

Steiner teaches that the memory circuit comprises an EPROM (see col. 5, lines 17-25).

Steiner fails to teach that the memory circuit comprises an EEPROM.

Endo teaches that both EPROM and EEPROM can be used to store programs (see col. 2, lines 55-66). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate Endo's teaching into Steiner's teaching because an EEPROM would be used to store test programs. Therefore, using

EEPROM would be more cost effective because it can be erased and reprogrammed for testing different electronic devices.

***Allowable Subject Matter***

4. **Claim 4** is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: none of the prior art of record teaches or suggests that the inspection program is created as an interactive type of displayed image on the external personal computer and transferred therefrom to the memory, in combination with the rest of the claim limitations.

***Response to Arguments***

5. Applicant's arguments with respect to claims 3 and 4 have been considered but are moot in view of the new ground(s) of rejection.

With respect to claim 1, Applicant argues, that Steiner teaches a test procedure memory circuit controlled and programmed by the integrated Microcomputer 20, which is not external to the testing circuit, whereas, the present invention teaches that the microcomputer is external to the signal inspection device.

Examiner sees that the limitation "said memory circuit being capable of being programmed by a personal computer external to said signal inspection device and detachably connectable thereto for programming said memory circuit to suit the electronic device to be tested" does not exclude the fact that the microcomputer could

be an internal part of the inspection device. Furthermore, The fact that a given structure is integral does not preclude its consisting of various elements see Nerwin v. Erlichman, 168 USPQ 177, 179 (PTO Bd. Of Int. 1969). Therefore, the memory circuit being able to be programmed by an external computer would not change the final outcome of the tester.

With respect to claim 1, Applicant argues that Steiner controls the power supply from the integral PC 20.

Examiner disagrees with the Applicant arguments, because figure 2, shows that the power-supply operates independently from the microcomputer 20.

With respect to claim 1, Applicant argues that Steiner's only display a "go" or "no go" signal.

Examiner disagrees with the Applicant arguments, because Examiner could not find in the Steiner's reference that only a "go" or "no go" signal is displayed as a test result when a device has been tested. In fact, Steiner teaches that an appropriate message is displayed if the unit under test is operating properly or the step in the test procedure in which the unit under test fails is shown in the display (see col. 4, lines 5-12).

With respect to claim 2, Applicant argues that Steiner's does not teach that the display is driven solely by the signal inspection device and operates independently of any personal computer and that the display is driven by the PC.

Examiner disagrees with the Applicant arguments. Figure 2, shows that the display is connected to the circuit 25 to display the test results. Furthermore, Steiner does not teach that the display is driven and controlled by the PC.

With respect to claim 5, Applicant argues that Steiner fails to teach a memory circuit for storing an inspection program adapted to the electronic device and capable of being programmed by an external personal computer.

Examiner disagrees with the Applicant arguments. Steiner does teach a memory circuit for storing an inspection program adapted to the electronic device (see col. 3, lines 40-49). The limitation "the inspection program is capable of being programmed by an external personal computer" does not exclude the fact that the microcomputer could be an internal part of the inspection device. Furthermore, The fact that a given structure is integral does not preclude its consisting of various elements see Nerwin v. Erlichman, 168 USPQ 177, 179 (PTO Bd. Of Int. 1969). Therefore, the memory circuit being able to be programmed by an external computer would not change the final outcome of the tester.

#### **Prior art**

6. The prior art made record and not relied upon is considered pertinent to applicant's disclosure:

**Lentz et al. ['444]** disclose method and apparatus for automatic performance evaluation of electronic display devices.

**Fontenot et al. ['177]** disclose method and apparatus for testing a circuit module concurrently with a non-volatile memory operation in a multi-module data processing system.

**Lessin et al. ['376]** disclose intelligent portable interactive personal data system.

#### **Contact information**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohamed Charioui whose telephone number is (571) 272-2213. The examiner can normally be reached Monday through Friday, from 9 am to 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc S Hoff can be reached on (571) 272-2216. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mohamed Charioui

9/30/04



PATRICK ASSOUAD  
PRIMARY EXAMINER